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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/325,189	06/03/1999	MASATAKA KINJO	990360/LH	2516

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EXAMINER

TUNG, JOYCE

ART UNIT PAPER NUMBER

1637

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/325,189

Applicant(s)

Kinjo

Examiner

Joyce Tung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 16, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-39, 42, and 43 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 39, 42, and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-5, 7-39, 42, and 43 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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***Response to Amendment***

1. The amendment filed 12/16/2002 has been entered.
2. The rejection of claims 1-5, 7-8, 39 and 42-43 under 35 U.S.C. 103(a) as being unpatentable over Eigen et al. (5,807,677), and in view of Gyllensten et al. (Proc. Natl. Acad. Sci. USA, 1988, Vol. 85, pg. 7652-7656) and Wang et al. (5,567,583) is withdrawn.

**NEW GROUND REJECTION**

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. claims 1-5, 7-8, 39 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salituro et al. (6,391,544) in view of Eigen et al. (5,807,677).

Salituro et al. disclose a method for detecting a target sequence in a test sample employing a pair of primer sequences to generate copies of the target sequence (See column 1, lines 7-10). The first primer and second primer are referred to as a "primer pair" (See column 3, lines 21-23). The first primer is added to the amplification mixture such that its concentration is between 15% to 250% greater than the concentration of the second primer (See column 3, lines

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61-64). If desired, a primer can be labeled using methodologies well known in the art (See column 4, lines 12-13). The label can be detectable label, for example fluorophores (See column 5, lines 35-39). The labeled primer was at a concentration of 50 nM and the unlabeled primer concentration was varied at the concentration 25, 37.5, 50 or 62.5 nM. The experiments results are that when the unlabeled primer is present at concentration lower than the labeled primer, higher signals are achieved at higher target concentration and when the concentration of unlabeled primer is higher than or equal to the concentration of labeled primer, the higher signals are achieved at medium target concentration (See column 8, lines 18-40).

Salituro et al. do not disclose evaluating a fluctuation motion of the amplified nucleic acid to quantifying the target nucleic acid and specific ratio the concentration of the primers as claimed in claims 42-43.

Eigen et al. disclose fluorescence correlation spectroscopy (FCS) method which requires a specific primer sequence marked with fluorescence dye (See column 2, lines 31-32). The measuring principle with FCS is based on the fact that fluorogenic molecules can be measured in extremely diluted solutions by exposing a small volume element of the solution (See column 2, lines 38-41). The fluorescence correlation spectroscopy (FCS) has a number of advantage compared to the PCR method in which FCS can be used for both single stranded and double stranded nucleic acid molecules and is more direct identifying the individual nucleic acids (See column 3, lines 46-57).

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Since the method of Salituro et al. provides the quantitative signal of the labeled amplified nucleic acid products (See column 8, lines 30-40), one of ordinary skill in the art would have motivated to apply the FCS method to the method of Salituro et al. at the time of the instant invention. The motivation is based upon the discussion of the advantage of using FCS as addressed by Eigen et al. above. Moreover, although Salituro et al. do not disclose the specific ratio of the concentration of the primers as claimed in claims 42-43, Salituro et al. do disclose the comparison experiment using different ratio concentration of two different primers. Thus, one of ordinary skill in the art would have optimized the concentration ratio of the two primer based upon the teachings of Salituro et al. It would have been prima facies obvious to carry out the method as claimed.

5. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

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6. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

<sup>J.T.</sup>  
February 19, 2003



Ethan Whisenant, Ph.D.  
Primary Examiner  
Art Unit 1634